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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,894	04/13/2004	Jerry Shifman	94-25d	5654
30699	7590	12/22/2004		
DAYCO PRODUCTS, LLC 1 PRESTIGE PLACE MIAMISBURG, OH 45342				
			EXAMINER RAYFORD, SANDRA M	
			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,894

Applicant(s)

SHIFMAN, JERRY

Examiner

Sandra M. Nolan

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004 and 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims

1. Claims 1-20 are pending. Claims 12-20 were claims 13-21 earlier.

Withdrawal of Allowance

2. The allowance of claims 12-21 is withdrawn in order to apply new rejections.

Declaration

3. The new declaration in the 20 September 2004 response has been entered.

Priority

4. The priority recitation in the 20 September 2004 response has been entered.

Rejections Withdrawn

5. The 35 USC 112 rejection of claim 11 for reciting trademarks, as set out in section 10 of the 09 August 2004 office action ("the last office action"), is withdrawn in view of the amendments in the 20 September 2004 response ("the last response").
6. The 35 USC 112 rejection of claims 1-10 for indefiniteness, as set out in section 11 of the last office action, is withdrawn in view of the amendments in the last response.

New Rejections

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/823,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because a fluoropolymer containing 68 to 74% fluorine (claim 1, line 4 and claim 11, line 4 of this application) is obvious over one containing 68 to 75% fluorine (claim 1, lines 4-5 of the '893 application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 12-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. 6,365,250. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

a. The use of 5 to 95% of the first fluoropolymer (claim 1, line 3 of this application) is obvious over the 20 to 80% used in the patent (claim 1, line 6).

b. The use of 68 to 74% fluorine (claim 1, line 4 of this application) is obvious over the use of 68 to 73% fluorine in the first fluoropolymer (claim 1, line 7 of the patent).

c. The extruding steps of claim 12, lines 3 and 11 of this application are conventional ways of "forming" barrier/protective layers (per claim 1, lines 2 and 3 of the patent).

10. Claims 2-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-20 of U.S. 6,203,873. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

a. The use of 5 to 95% of the first fluoropolymer (claim 1, line 3 of this application) is obvious over the 20 to 80% used in the patent (claim 1, line 1 and claim 19, line 3).

b. The use of 68 to 74% fluorine (claim 1, line 4 of this application) is obvious over the use of 65 to 73% fluorine in the first fluoropolymer (claim 1, line 3 and claim 19, line 4 of the patent).

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time. If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498. The fax number for patent application documents is 703/872-9306.

S. M. Nolan-Rayford
S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

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